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| 10/526,694  | 03/03/2005  | Hugo Camenzind       | LA/1-22745/A/PCT    | 5272             |
| 324   | 7590        | 05/05/2009           | EXAMINER            |                  |
| JoAnn Villamizar<br>Ciba Corporation/Patent Department<br>540 White Plains Road<br>P.O. Box 2005<br>Tarrytown, NY 10591 |             |                      | GOLOBOY, JAMES C    |                  |
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andrea.dececchis@ciba.com  
deborah.pinori@ciba.com  
sonny.nkansa@basf.com



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/526,694  
Filing Date: March 03, 2005  
Appellant(s): CAMENZIND ET AL.

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Shiela Loggins  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/17/09 appealing from the Office action mailed 9/17/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|           |        |         |
|-----------|--------|---------|
| 4,882,077 | COX    | 11-1989 |
| 5,362,375 | KUBO   | 11-1994 |
| DE2054659 | AMENDE | 5-1972  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox (U.S. Pat. No. 4,882,077) in view of Amende (DE 2,054,649).

In column 2 lines 7-27, Cox discloses metalworking fluids comprising a paraffin oil and an emulsifier, which can be diluted to form an oil-in-water emulsion. In column 3 lines 24-27 Cox discloses that the composition is first made in concentrate form without water, as recited in claim 7. The paraffin oil meets the limitations of the base oils of claims 4-6 and 8. In column 4 lines 20-25 Cox discloses that any oil-in-water emulsifier can be used in the composition, but does not specifically disclose the compounds of claims 4-5.

Amende, on pages 9-12, discloses the preparation of a compound by the reaction of an acrylic acid ester and alkylamines such as laurylamine, stearylamine, and

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oleyl amine, followed by further reaction with maleic anhydride. On page 6 Amende discloses that succinic anhydride can be used in place of maleic anhydride. When succinic anhydride is used, the reaction of Amende is the same as those discloses in the examples in the specification of the current application, and therefore the product has a structure meeting the limitations of claims 4-6 and 8. On page 1, Amende discloses that the compound is useful as an emulsifier, and can be an ammonium salt. The use of the compound of Amende as the emulsifier in the metalworking fluid composition of Cox meets the limitations of claims 4-8.

It would have been obvious to one of ordinary skill in the art to use the compound of Amende in the metalworking fluid of Cox, as Amende teaches that the compound acts as an emulsifier.

Claims 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo (U.S. Pat. No. 5,362,375) in view of Amende.

In column 1 lines 5-12, Kubo discloses an oil composition substantially free from thermal deterioration and carbonaceous deposition at high temperatures. In column 2 lines 21-61, Kubo discloses that the composition comprises a base oil, meeting the limitations of component (b) of claims 4-5, and in column 5 lines 11-21 discloses that the compositions can be used as engine oils or gear oils, as recited in claim 6. In column 4 line 66, Kubo discloses that the composition can further comprise an emulsifier, but does not disclose specific suitable emulsifiers.

The discussion of Amende above is incorporated here by reference. The use of the compound of Amende in the composition of Kubo meets the limitations of claims 4-6 and 8, and would have been obvious to one of ordinary skill in the art as Amende teaches that the compound acts as an emulsifier.

#### **(10) Response to Argument**

Appellant argues that "Amende gives no direction to use his textile adjuvants in a base oil of lubricating viscosity", and that "one skilled in metalworking fluids would not look to Amende to replace the emulsifiers in Cox with the textile adjuvants of Amende". Appellant's characterizations of the compounds of Amende as textile adjuvants, and of the Amende reference as being in the textile adjuvant art are tendentious, as Amende teaches that the compounds are equally useful as emulsifiers, and the reference can equally be considered in the emulsifier art. Given Cox's broad teaching that *any* oil-in-water emulsifier is suitable, one of ordinary skill in the art clearly would have had a reasonable expectation of success in using the emulsifiers of Amende in the composition of Cox.

Appellant argues that the teaching of Cox (any oil-in-water emulsifier) is so broad as to give no direction as to which emulsifiers are likely to be successful. To the contrary, the breadth of Cox's teaching is itself guidance; Cox teaches that any oil-in-water emulsifier is likely to be successful.

Appellant further argues that the results given on page 21 of the specification demonstrate that the claimed combination of the structures of formula (I) and a base oil

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of lubricating viscosity give unexpectedly superior results. However, the results are not commensurate with the scope of the claims. The inventive examples comprise the compound of formula (I) at a concentration of 0.1 mmol/kg, or 0.03 to 0.06% by weight, while the claims do not place any limitations on the concentrations of the compound of formula (I). Appellant argues that "It makes no sense to compare different molar concentrations against each other in the same test as this would not give the tester any indication of which species might work best". While this is true for determining which species works best at a given concentration, the fact remains that appellant has only determined which species works best at a concentration range representing a tiny portion of the scope of the claim. Appellants allegations of unexpected results are therefore clearly not sufficient to rebut the case of obviousness over Cox and Amende.

Appellant's arguments regarding the rejection of claims 4-6 and 8 as obvious over Kubo and Amende are similar to those made for the rejection over Cox and Amende, and the examiner maintains the positions taken above. The composition of Kubo comprises emulsifiers, and does not place any limitation on the emulsifier. One of ordinary skill in the art would have looked to an emulsifier reference, such as that of Amende, in order to supply an emulsifier, and would have had a reasonable expectation of success in using the emulsifier of Amende in the composition of Kubo.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James Goloboy

/James C. Goloboy/

Conferees:

/Glenn A Caldarola/

Acting SPE of Art Unit 1797

/Christopher A. Fiorilla/

Chris Fiorilla

Supervisory Patent Examiner, Art Unit 1700